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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFF ABEL

Appeal 2009-1897
Application 10/616,460
Technology Center 3600

Decided:¹ June 1, 2009

Before DONALD E. ADAMS, ERIC GRIMES, and MELANIE L.
McCOLLUM, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a fishing net and a method of using it. The Examiner has rejected the claims as

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

anticipated and obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

The Specification discloses “a sport fishing net with a length measuring scale incorporated into the net, such that a user may visually determine the length of a fish contained in the net” (Spec. 1: 6-9).

Figure 1 of the Specification is shown below.

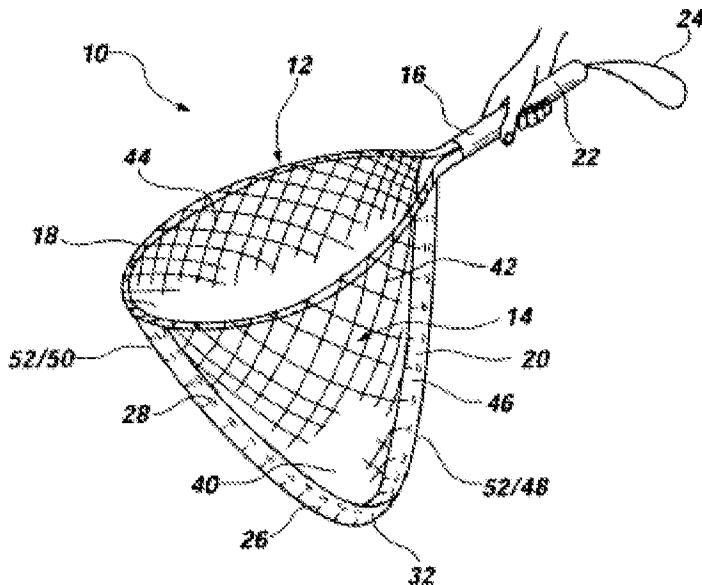


Figure 1 shows “a perspective view of a fish net with length measuring scale” (*id.* at 3: 18-20).

Claims 1, 2, 4-14, 16-18, and 20-24 are on appeal. Claim 1 is representative and reads as follows:

Claim 1: A fish net device, comprising:
a. a frame;
b. a net of flexible net material, attached to the frame, the frame holding the net in a position to land a fish; and
c. a flexible length measuring scale, permanently disposed generally linearly on a surface of the net, such that a user may determine a size of the

fish held in the net by visually comparing the fish with the length measuring scale.

The claims stand rejected as follows:

- claims 1-2, 4, 11, 18 and 22-24 under 35 U.S.C. § 102(b) as being anticipated by Chat;²
- claims 5-10, 13, 14, 16, 17, 20 and 21 under 35 U.S.C. § 103(a) as being obvious in view of Chat and Bryant;³ and
- claim 12 under 35 U.S.C. § 103(a) as being obvious in view of Chat and Caddis.⁴

ANTICIPATION

Issue

The Examiner has rejected claims 1-2, 4, 11, 18 and 22-24 under 35 U.S.C. § 102(b) as anticipated by Chat. The Examiner finds that Chat discloses a fish net comprising, among other things, “a flexible length measuring scale ... permanently disposed generally linearly on a surface of the net, such that a user may determine a size of a fish held in the net by visually comparing the fish with the length measuring scale” (Ans. 3)

Appellant contends that the Examiner erred in concluding that Chat discloses a flexible length measuring scale (Appeal Br. 11).

² Chat, FR 2,582,190, Nov. 28, 1986. Our citations are to the English-language translation of record.

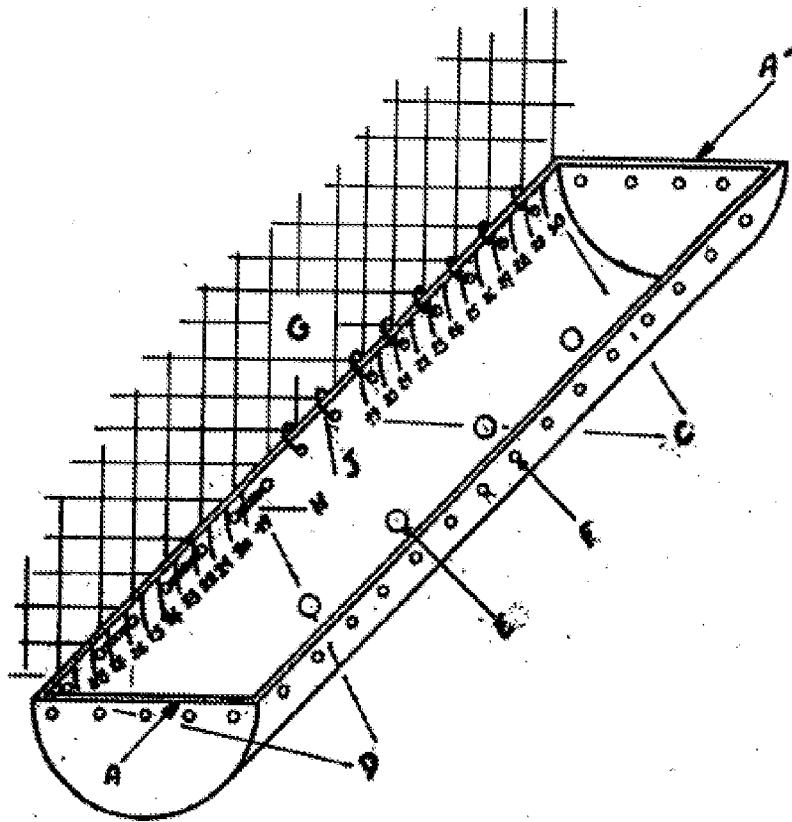
³ Bryant et al., US 5,501,026, Mar. 26, 1996.

⁴ Caddis Manufacturing, Inc. online catalog page 1, 2000, downloaded Oct. 09, 2002 at <http://www.caddis.com/Sorts/u-shaped.htm>.

The issue with respect to this rejection is: Does the evidence of record support the Examiner's finding that Chat discloses a fishing net comprising "a flexible length measuring scale" as recited in claim 1?

Findings of Fact

1. Chat discloses a gauge that allows "fishermen to measure fish quickly and precisely regardless of the orientation of the fish in the gauge, and without having to unhook the bait or touching the fish" (Chat 1).
2. Chat discloses that the "gauge is in the form of a molded plastic or drawn metal channel" (*id.*).
3. Chat discloses that the "cross section of the channel may be rectangular, round, oval, etc." (*id.*).
4. The Figure of Chat is shown below:



The Figure shows that the “bottom of the netting (G) is affixed to the gauge by means of holes, which are arranged over the periphery of the gauge by means of a cord (H), which passes alternately through each hole or ring (J) and into the mesh of the net” (*id.* at 2).

5. Chat discloses that “[w]hen the fish is caught with the help of this landing net, it lands directly in the gauge” (*id.*).

Principles of Law

“To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.” *PPG Indus. Inc. v. Guardian Indus. Corp*, 75 F.3d 1558, 1566 (Fed. Cir. 1996).

Analysis

Claim 1 is directed to a fishing net that comprises, among other things, a flexible-length measuring scale disposed on a surface of the net.

Appellant argues that Chat does not disclose a flexible length measuring scale because Chat “discloses a rigid gutter with length markings. ... The relative inflexibility of the gutter is implicit in Chat because the gutter would not be able hold a fish if it were flexible to any significant extent” (Appeal Br. 11). Appellant also argues that “there is no indication in Chat that suggests that this gutter is or can be flexible” (*id.*).

The Examiner reasons that Chat’s length-measuring scale “is deemed flexible in that it contains flexible connection elements – at H being cords, straps or – at J being ring elements which allow for the measuring scale to be flexibly connected to the net” (Ans. 9).

Appellant's arguments are persuasive. Claim 1 recites "a flexible length measuring scale." The Specification's Figure 1, which is said to show an embodiment of the disclosed net, shows a length-measuring scale with sufficient flexibility to conform to the shape of the net. Giving the claim language its ordinary meaning, and reading it in light of the Specification, one of skill in the art would interpret the claim to require that the length-measuring scale itself is flexible rather than simply requiring that the length-measuring scale comprises flexible elements.

Chat discloses that its length-measuring scale is made from molded plastic or metal. The Examiner has not adequately explained how Chat discloses the claim limitation of claim 1 of "a flexible length measuring scale." The anticipation rejection of claim 1 is reversed.

Claims 2, 4, 11, and 22-24, depend directly or indirectly from claim 1. The rejection of these claims as anticipated by Chat is reversed for the reasons discussed above.

Claim 18 is directed to a method of measuring a size of fish that comprises, among other steps, placing a fish within a fish net device that has "a flexible length measuring scale" disposed on the net material. Thus, the rejection is reversed for the reasons discussed.

Conclusions of Law

The evidence of record does not support the Examiner's conclusion that Chat discloses "a flexible length measuring scale" as recited in claim 1.

OBVIOUSNESS I

The Examiner has rejected claims 5-10, 13, 14, 16, 17, 20 and 21 under 35 U.S.C. § 103(a) as obvious in view of Chat and Bryant (Ans. 5, 7, 9).

Claims 5-10 and 13 depend on claim 1 and claim 20 depends from claim 18. The Examiner relies on Chat as discussed above and provides the Bryant reference to supply dependent claim limitations. As discussed above, however, the Examiner has not adequately explained how the cited references would have suggested the claimed “flexible length measuring scale.” The rejection of claims 5-10, 13 and 20 is reversed.

Claim 14 is independent and, like claim 1, is directed to a fish net device that comprises “a flexible length measuring scale.” The Examiner relies on Chat as discussed above and finds that Bryant discloses a handle, a substantially closed loop portion attached to the handle, and the net being attached to the closed loop portion (Ans. 8). However, the Examiner has pointed to nothing in Bryant to suggest the flexible length-measuring scale missing from Chat. Claims 16, 17 and 21 depend from claim 14. Thus, the rejection of claims 14, 16, 17, and 21 is reversed for the reasons discussed above.

OBVIOUSNESS II

Issue

The Examiner has rejected claim 12 under 35 U.S.C. § 103(a) as obvious in view of Chat and Caddis.

The Examiner relies on Chat as discussed above, but acknowledges that Chat does not disclose the length-measuring gauge disposed directly on the net by weaving, embroidering, printing, or silk-screening, as recited in

claim 12 (Ans. 7). The Examiner relies on Caddis as disclosing that the “length measuring scale is disposed directly on the net by a process selected from the group consisting of weaving into the material of the net, embroidering onto the material of the net, printing on the material of the net, and silk-screening on the material of the net” (*id.*). The Examiner concludes that “it would have been obvious to one of ordinary skill in the art to take the fish net of [Chat] and add the measuring scale disposed on the net from one of the methods described above of Caddis, so as to make the device more durable in that the length scale is permanently attached to the net” (*id.*).

Appellant contends that the Examiner erred in concluding that the cited references suggest the invention of claim 12 because there is no motivation to combine the cited references to arrive at the invention of claim 12 (Appeal Br. 27-28).

The issue with respect to this rejection is: Does the evidence of record support the Examiner’s conclusion that one of skill in the art would have been motivated to combine the cited references to arrive at the invention of claim 1?

Additional Findings of Fact

6. Chat discloses that the “double gradations [printed on the gauge] allow the size of the fish to be read regardless of the orientation of the fish by making the fish slide against the end piece, which is opposite the nose of the fish, so that the length of the fish can be read” (Chat 2).

7. Chat discloses that “[i]f the fish is too small to be kept by the fisherman, the fish is immobilized in the gauge by clamping it with the help of the netting to the landing net. As a result, it is possible to unhook the bait without having to touch the fish” (*id.*).

8. Caddis discloses a U-shaped float tube that includes a “wide nylon coated all mesh working and stripping apron” (Caddis 1).

9. The Examiner finds that the pictures shown in Caddis include a “length measuring scale … disposed directly on the net” (Ans. 7).

10. Appellant states that “[t]here appears to be a length measuring scale printed upon th[e] stripping apron” of the Caddis float tube (Appeal Br. 25).

Principles of Law

“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. … [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

“We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention.” *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008).

Analysis

Claim 12 depends on claim 1, and further requires that “the length measuring scale comprises markings disposed directly on the net material, said markings being selected from the group consisting of: woven markings; embroidered markings; printed markings; and silk-screened markings.”

The Examiner finds that the additional limitation would have been suggested by Caddis (Ans. 7). Appellant contends that the Examiner has not

provided adequate reason to combine the elements of Chat and Caddis (Appeal Br. 27-28). Appellant also contends that the resulting product “would be non-functional because one could not measure a fish in the gutter according to the teachings of Chat. Chat requires that a fish be placed in the gutter with its nose abutting one of the end stops” (*id.* at 28).

We agree with Appellant that the Examiner has not shown that the product of claim 12 would have been obvious based on Chat and Caddis. Chat discloses a rigid gauge that serves the purposes of holding fish to allow measurement in either orientation and allowing hook removal without handling the fish (FFs 1, 6 and 7). Caddis discloses a float tube that includes a stripping apron with a length-measuring scale printed on it. Given the stated purposes of Chat’s gauge, the Examiner has not adequately explained why one of skill in the art would have considered it obvious to replace the gauge with markings directly on the netting. Removal of the gauge would appear to defeat the purposes of the Chat device because the modified device would not allow the fish to be held for measuring without adjustment or allow hook removal without handling the fish.

Conclusions of Law

The evidence of record does not support the Examiner’s conclusion that one of skill in the art would have been motivated to combine the cited references to arrive at the invention of claim 12.

SUMMARY

We reverse the rejection of claims 1-2, 4, 11, 18 and 22-24 under 35 U.S.C. § 102(b) as anticipated by Chat. We also reverse the rejections under 35 U.S.C. § 103(a) of claims 5-10, 13, 14, 16, 17, 20 and 21 as obvious in

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view of Chat and Bryant and of claim 12 as obvious in view of Chat and Caddis.

REVERSED

LP

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